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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,427	03/31/2004	Paul Buchheit	060963-5008US	8813
83750 7590 09/11/2009 Morgan, Lewis & Bockius LLP/Google 2 Palo Alto Square 3000 El Camino Real Palo Alto, CA 94306				
EXAMINER				
STRANGE, AARON N				
ART UNIT		PAPER NUMBER		
2448				
NOTIFICATION DATE		DELIVERY MODE		
09/11/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/816,427

Applicant(s)

BUCHHEIT ET AL.

Examiner

AARON STRANGE

Art Unit

2448

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-22, 32-37 and 41-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-22, 32-37 and 41-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's amendments and arguments with respect to the rejection of claims 15, 20, 32 and 37 under 35 U.S.C. § 112 and the objections to claims 17, 19, 21, 34 and 36 under 37 C.F.R. § 1.75(c) have been considered and are persuasive. Those rejections/objections have been withdrawn.
2. Applicant's arguments with respect to the rejection of claims 20-22 under 35 U.S.C. § 101 have been fully considered and are persuasive. That rejection has been withdrawn.
3. Applicant's remaining arguments with respect to claims 15-22 and 32-37 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 15-19, 21, 32-25 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moody et al. (US 2005/0144157) in view of Durazo et al. (US 2005/004990).

6. With regard to claim 15, Moody discloses a method of searching conversations, comprising:

at a server: (threading service 110 may be on server 108)(¶24)

receiving a search query from a client (client inputs search terms into query box 564)(¶54-57);

identifying a plurality of threads relevant to the search query (messages containing the search term, and all messages in the same thread are identified)(¶57), the plurality of threads including at least two threads each having two or more messages (at least the message containing the search term and the related message)(¶57) sharing a common set of characteristics that meet predefined criteria (the messages are part of the same "thread") and a respective conversation identifier (thread identifier)(¶57); and

returning the conversation to the client a list of the identified threads as a search result to the search query (conversations containing the search terms are returned to the client)(¶57-60).

It is clear from the disclosure of Moody that the system will return a list of all messages satisfying the search criteria and their associated threads. While Moody fails to specifically state that two or more conversations are returned, one of ordinary skill in

the art would have understood Moody's disclosure to at least suggest such an embodiment.

However, Moody fails to specifically disclose that the list of identified conversations are displayed with each conversation represented as a single item in the list, wherein at least one of the conversations in the list comprises two or more electronic messages from distinct senders.

Durazo teaches displaying a list of conversations as a list with each conversation represented as a single item in the list (each conversation is displayed as a separate grouping and separated by a box in the GUI)(fig. 3; ¶36-39). Durazo also discloses that at least one of the conversations comprises two or more electronic messages from distinct senders (fig. 3, conversation grouping 310). This would have been an advantageous addition to the system disclosed by Moody since it would have allowed conversations to be grouped together and visually separated from each other in the GUI used to view the messages.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to display conversations in a list where each conversation is represented as a single item in the list so that the conversations may be quickly and easily distinguished from one another.

7. With regard to claim 16, Moody further discloses that the identifying the conversation includes identifying a first message relevant to the search query (the message containing the search term)(¶57).

8. With regard to claim 17, Durazo further discloses that the single item representing a respective conversation includes a list of sender identifiers corresponding to senders who have sent messages in the conversation (conversation group lists the most recent sender or all senders each conversation, depending on whether the conversation listing is expanded)(fig.3; ¶38).
9. With regard to claim 18, Durazo further discloses that the list of sender identifiers are ordered according to their respective message arrival time (fig. 3; ¶8).
10. With regard to claim 20, Moody further discloses a method of searching messages, comprising:
- searching a message repository (Fig. 1 #110) to identify two or more messages (Fig. 5 #564) relevant to a search query, wherein each identified message is associated with a respective conversation (thread) of a plurality of conversations (Fig. 2 #224), each conversation having a respective conversation identifier (a thread identifier is inherently present to identify all messages in a thread), wherein at least one respective conversation of the plurality of conversations comprises two or more messages sharing a common set of characteristics that meet predefined criteria (at least the message containing the search term and the related message are part of the conversation) (¶0057);

identifying the respective conversation identifiers of the conversations associated with the one or more identified messages (each thread is identified and returned to the user) (§0057);

creating a list of conversations, each of the conversations in the list corresponding to a respective identified conversation identifier (§0057-60); and

producing at least a portion of the list of conversations as the search result (threads containing the search terms are returned and displayed)(§0057-60).

It is clear from the disclosure of Moody that the system will return a list of all messages satisfying the search criteria and their associated threads. While Moody fails to specifically state that two or more conversations are returned, one of ordinary skill in the art would have understood Moody's disclosure to at least suggest such an embodiment.

However, Moody fails to specifically disclose that the list of identified conversations are displayed with each conversation represented as a single item in the list, wherein at least one of the conversations in the list comprises two or more electronic messages from distinct senders.

Durazo teaches displaying a list of conversations as a list with each conversation represented as a single item in the list (each conversation is displayed as a separate grouping and separated by a box in the GUI)(fig. 3; ¶36-39). Durazo also discloses that at least one of the conversations comprises two or more electronic messages from distinct senders (fig. 3, conversation grouping 310). This would have been an advantageous addition to the system disclosed by Moody since it would have allowed

conversations to be grouped together and visually separated from each other in the GUI used to view the messages.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to display conversations in a list where each conversation is represented as a single item in the list so that the conversations may be quickly and easily distinguished from one another.

11. With regard to claim 21, Durazo further discloses that the single item representing a respective conversation includes a list of sender identifiers corresponding to senders who have sent messages in the conversation (conversation group lists the most recent sender or all senders each conversation, depending on whether the conversation listing is expanded)(fig.3; ¶38).

12. Claims 32-35 and 37 are rejected under the same rationale as claims 15-18, 20 and 21, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are explicitly or inherently taught by the above cited art.

13. Claims 19, 22 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moody et al. (US 2005/0144157) in view of Durazo et al. (US 2005/004990) further in view of Official Notice.

14. With regard to claims 19, 22 and 36, while the system disclosed by Moody and Durazo shows substantial features of the claimed invention (discussed above), it fails to disclose that at least one sender identifier is represented by an icon or unique character string distinct from the names of the senders.

The Examiner takes Official Notice that the name of an electronic mail user is not always known, and that identifying a sender of an electronic mail by the address from which the mail was sent was old and well known in the art at the time the invention was made. This would have been an advantageous addition to the system taught by Moody and Durazo since it would have allowed senders of electronic messages to be uniquely identified when the sender's name is unknown.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to identify unknown senders using their e-mail address to provide a mechanism to uniquely identify unknown users.

15. Claims 41-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moody et al. (US 2005/0144157) in view of Durazo et al. (US 2005/004990) further in view of Baldonado (US 7,035,903).

16. With regard to claim 41, while the system disclosed by Moody and Durazo shows substantial features of the claimed invention (discussed above), it fails to disclose that the predefined criteria includes a subject of the two or more messages and information

other than the subject, an in-reply-to field, a references field and a message identifier field of the two or more messages, although Moody does disclose that the threading mechanism is not limited to any particular mechanism (§28).

Baldonado discloses a similar system for identifying messages that are conversationally-related to each other (Abstract). Baldonado teaches matching messages based on various criteria, including the subject of the messages (col. 4, ll. 65-66) and information other than the subject, a reply-to field, a references field and a message identifier field (e.g., location, recency, keyword, etc) (col. 4, ll. 62-67). This would have been an advantageous addition to the system disclosed by Moody since it would have allowed messages to be classified as being part of the same thread or conversation based on various criteria as desired by the user (Baldonado, col. 5, ll. 1-2).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to associate messages into conversations/threads based on various criteria including the subject of the messages and other non-subject criteria to allow users to define conversations/threads according to their desired classification.

17. Claims 42-44 are rejected under the same rationale as claim 41, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are explicitly or inherently taught by the above cited art.

Conclusion

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to AARON STRANGE whose telephone number is (571)272-3959. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Firmin Backer can be reached on 571-272-6703. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Aaron Strange/
Primary Examiner, Art Unit 2448